

REMARKS

Reconsideration of this application is respectfully requested in view of the following remarks.

Claims 10-29 are currently pending in the application and subject to examination.

In the Office Action mailed January 3, 2007, the Examiner rejected claims 10-29 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,054,984 to Chan et al. ("Chan") in view of U.S. Patent No. 5,666,493 to Wojcik ("Wojcik").

The Applicant submits that Chan does not disclose or suggest a method for tracking purchases of electronic books including at least the combination of storing identifications of a plurality of electronic books for display on a viewer; associating each of the electronic books with a source; providing the electronic books for purchase by subscribers; and recording an indication of purchases of the electronic books, as recited in claim 10.

Chan teaches a "binding line book tracking system." Although the referenced section lists an "electronic book tracking means or system," Chan as referenced merely discloses a system for electronically tracking the physical location of a hard copy book during the binding process through the use of a code such as a bar code rather than a method for tracking purchases of electronic books, as recited in claim 10. (See Chan column 7, lines 42-51).

For at least this combination of reasons, the Applicant submits that claim 10 is allowable over the cited art. For reasons similar to those discussed for claim 10, the Applicant submits that claims 15, 20, and 25 are likewise allowable. As claims 10, 15, 20, and 25 are allowable, the Applicant submits that claims 11-14, 16-19, 21-24, and

26-29, which depend from allowable claims 10, 15, 20, and 25, are therefore also allowable for at least the above noted reason and for the additional subject matter recited therein.

With regard to each of the rejections under §103 in the Office Action, it is also respectfully submitted that the Examiner has not yet set forth a *prima facie* case of obviousness. The PTO has the burden under §103 to establish a *prima facie* case of obviousness. In re Fine, 5 U.S.P.Q.2nd 1596, 1598 (Fed. Cir. 1988). Both the case law of the Federal Circuit and the PTO itself have made clear that where a modification must be made to the prior art to reject or invalidate a claim under §103, there must be a showing of proper motivation to do so. The mere fact that a prior art reference could arguably be modified to meet the claim is insufficient to establish obviousness. The PTO can satisfy this burden only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references. Id. In order to establish obviousness, there must be a suggestion or motivation in the reference to do so. See also In re Gordon, 221 U.S.P.Q. 1125, 1127 (Fed. Cir. 1984) (prior art could not be turned upside down without motivation to do so); In re Rouffet, 149 F.3d 1350 (Fed. Cir. 1998); In re Dembiczak, 175 F.3d 994 (Fed. Cir. 1999); In re Lee, 277 F.3d 1338 (Fed. Cir. 2002).

In the Office Action, the Examiner merely states that the present invention is obvious in light of the cited references. See, e.g., Office Action at page 3. This is an insufficient showing of motivation.

CONCLUSION

For all of the above reasons, it is respectfully submitted that the claims now pending patentability distinguish the present invention from the cited references. Accordingly, reconsideration and withdrawal of the outstanding rejections and an issuance of a Notice of Allowance are earnestly solicited.

Should the Examiner determine that any further action is necessary to place this application into better form, the Examiner is encouraged to telephone the undersigned representative at the number listed below.

In the event this paper is not considered to be timely filed, the Applicants hereby petition for an appropriate extension of time. The fee for this extension may be charged to our Deposit Account No. 01-2300. The Commissioner is hereby authorized to charge any fee deficiency or credit any overpayment associated with this communication to Deposit Account No. 01-2300, with reference to Attorney Docket No. 026880-00034.

Respectfully submitted,

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